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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,292	03/27/2001	Daniel F. Williams	PSTM0042/MRK	1726

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EXAMINER	
WEBB, JAMISUE A	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/820,292	WILLIAMS ET AL.	
	Examiner	Art Unit	
	Jamisue A. Webb	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 April 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-169* is/are pending in the application.

4a) Of the above claim(s) *28-38,66-76,104-114 and 142-169* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27,39-65,77-103 and 115-141* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 20010827, 20020104
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Claims 1-27, 39-65, 77-103 and 115-141 in the reply filed on 4/27/05 is acknowledged.

Information Disclosure Statement

2. The information disclosure statement filed 01/04/02 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The applicant has stated that redacted copies of applications have been submitted, but none of these pages are in the file. These references have not been considered, and are indicated on the IDS with a line through the listed reference. It has been placed in the application file, but the information referred to therein has not been considered.

3. The declarations filed with the Information Disclosure Statement filed 3/4/02, are not considered to be proper IDS references. They have been reviewed and considered and placed in the file, however are not considered to be a "reference cited".

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5-21, 43-59, 81-97 and 119-135 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 5, 43, 81 and 119 recite the limitation "the user". There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 101

Claims 39-46, 60, 62, 63, 115-122, 136, 138, and 139 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis for this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use or advance the technological arts.

In the present case, claims 39-46, 60, 62, 63, 115-122, 136, 138, and 139 only recite an abstract idea. The recited steps of merely receiving merchandise return requests, receiving a et of return policy rules, and processing the return request according to the rules, does not apply,

involve, use or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pen and paper. These steps only constitute an idea of how to process a return request.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is "computer implemented". Looking at the claim as a whole, nothing the body of the claim recites any structure of functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a return request that has been processed (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 39-46, 60, 62, 63, 115-122, 136, 138, and 139 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-10, 22-27, 39-48, 60-65, 77-86, 98-103, 115-124, and 136-141 are rejected under 35 U.S.C. 102(e) as being anticipated by Stenz (6,754,637).

9. With respect to Claims 1, 22-27, 39, 60-65, 77, 98-103, 115, 136-141: Stenz discloses the use of an online merchandise return computer system (see abstract) where the computer is programmed to

a. Save a set of return rules which is inputted by a merchant (see abstract);

b. Receive a return request by a consumer (See Figures 7 –9 with corresponding detailed descriptions);

c. Process return request according to the set of return rules (Column 3, lines 20-42).

10. With respect to Claims 2-9, 40-47, 78-85, and 116-123: Stenz discloses the use of a set or return questions (See Figures 7 and 8, such as reason for return and return credit choice), and processing the return according to the rules (See Claims 2-4).

11. With respect to Claims 10, 48, 86, and 124: Stenz disclose that a list of carriers can be used (See Figure 6, Shipping Options).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 11, 12, 27, 49, 50, 65, 87, 88, 103, 125 and 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stenz in view of Kara (6,233,568).

15. With respect to Claims 11, 49, 87 and 125: Stenz, as disclosed above for Claims 1, 39, 11 and 115, disclose the use of selecting a carrier for shipment, but fails to disclose the use of calculating the shipping rate for the return. Kara discloses calculating shipping rates for a plurality of carrier (See Figure 8, with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stenz, to include calculating shipping rates, according to Kara, in order to for the user to make an informed choice as to the most preferable method of shipment. (See Kara, abstract).

16. With respect to Claims 12, 27, 50, 65, 88, 103, 126 and 141: See Kara Figure 8.

17. Claims 13-21, 27, 51-59, 65, 89-97, 127-135 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stenz and Kara as applied to claims 11, 49, 87, and 125 above, and further in view of UPS® Service Guide (www.ups.com) and FedEx® Services (www.fedex.com) and Barnett et al. (6,369,840).

18. With respect to Claims 13-16, 27, 51-54, 65, 89-92, 127-130: Stenz and Kara discloses an onscreen interactive display with a selection and comparison section for a plurality of carriers with a plurality of services (See Figure 8). However Kara does not specifically disclose the rates being calculated with respect to time. Both UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the time sensitive "urgency" services, as disclosed by FedEx® and UPS®, in order to ship thing and compete with a time advantage using guaranteed delivery times and to reduce costs, when delivery time is not of importance. (See Fed Ex Page 1). Kara, UPS® and FedEx® fail to disclose the use of a graph which simultaneously displays a graph of shipping fees and services, where one axis being date and one axis being time and where each cell is located at the intersection of the date and time. Barnet discloses the use of a calendar which can be sued for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to display the calculation of shipping rates, calculated by Kara, UPS® and FedEx®, in the format of a plurality of cells with date on one axis and time on another, as disclosed by Barnett, in order to provide a multi-layers system wherein different

categories can be overlaid on one another providing a single integrated display that allows a user to order or purchase a system based on the calendar day and time (See Barnett, column 2).

19. With respect to Claims 17, 55, 93 and 131: See Stenz, Column 9, Process Flow diagram.

20. With respect to Claims 18, 56, 94, and 132: See Kara, Figure 9.

21. With respect to Claims 19, 20, 57, 58, 95, 96, 133 and 134: See Stenz, Col. 8, lines 38-49.

22. With respect to Claims 21, 59, 97, and 135: See Stenz Figure 10, Blocks 1004 and 1006, with corresponding detailed description.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Junger (6,085,172) discloses a method for handling returns, and Siegel (US 2001/0047315) discloses the use of a system and method for remotely processing a return according to rules.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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